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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C.

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EXAMINER

GILLESPIE, BENJAMIN

ART UNIT

PAPER NUMBER

1796

NOTIFICATION DATE

DELIVERY MODE

07/14/2009

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/539,830

Applicant(s)

HEISCHKE ET AL.

Examiner

BENJAMIN J. GILLESPIE

Art Unit

1796

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 March 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-8,11,12 and 17-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-8,11,12 and 17-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S508)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

Note

1. Since the claims have not been amended and the grounds of rejection remain the same as set forth in the preceding Office Action mailed 1/14/2009, it is therefore proper to make the present action Final.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. **Claims 1, 3-8, 11-12, and 17-21** are is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
3. **Regarding claims 1, 3-8, 11-12, and 17-21:** The rejection has been previously set forth in paragraph 1 of the non-final rejection mailed 1/14/2009 and is herein incorporated by reference.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. **Claims 1, 3-8, 11-12, and 17-21** are rejected under 35 U.S.C. 103(a) as being unpatentable over Neuhaus et al (U.S. Patent 4,380,604) in view of Lokai et al (6,319,983) and in further view of Paulus et al (6,458,991).

5. **Regarding claims 1, 3-8, 11-12, and 17-21:** The rejection has been previously set forth in paragraphs 2-8 of the non-final rejection mailed 1/14/2009 and is herein incorporated by reference.

Response to Arguments

6. Applicant's arguments filed 3/25/2009 have been fully considered but are not persuasive.
7. Applicants argue that claims 1, 3-8, 11-12, and 17-21 are not rendered indefinite under 35 U.S.C. 112 2nd paragraph because one of ordinary skill would understand that the range "0.2 to 0" establishes a component as *optional*. While it is true that the range "0.2 to 0" establishes a component as optional, the preceding language of claims 1 and 19 state that "at least one" of said component must be present. This completely contradicts the optional limitation - how can the language "at least one" be satisfied if said component is completely excluded?
8. Applicants also argue the rejection of claims 1, 3-8, 11-12, and 17-21 under 35 U.S.C. 103(a) since the prior art fails to render obvious the claimed invention because it would not have been obvious to include the relied upon epoxy reaction step of Lokai et al in Neuhaus et al since the reaction systems of Lokai et al and Neuhaus et al are "entirely different".
9. In reply, it is noted that the reaction systems of Neuhaus et al and Lokai et al are different - had said reaction systems been identical, the examiner would not have relied on Lokai et al to cure the deficiencies of Neuhaus et al since an identical secondary teaching would have the same deficiencies as the primary reference.
10. Instead, the position is maintained that the secondary teachings of Lokai et al are suitable in the instant prima facie case of obviousness since Lokai et al provide motivation for reacting epoxy functional compounds with mixtures comprising hydroxyl-functional unsaturated esters since said mixture may still comprise unreacted (meth)acrylic acid. This residual (meth)acrylic acid may

adversely affect the users control over the desired COOH and OH numbers, and therefore interfere with the later reactions (i.e. with polyisocyanate). By reacting the epoxy functional compounds with the mixture comprising hydroxyl-functional unsaturated ester, the unwanted excess (meth)acrylic acid is consumed thereby giving the user better control over COOH and OH content and reactions with polyisocyanate.

11. Additionally, one would be motivated to react the epoxy compounds with the mixture comprising said hydroxyl-functional unsaturated partial ester **before** the reaction with polyisocyanate since it would reduce the amount of free (meth)acrylic acid present in said reaction mixture before the inclusion of polyisocyanate, which would increase the yield of urethane groups.

Conclusion

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

13. A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Benjamin J. Gillespie whose telephone number is 571-272-2472. The examiner can normally be reached on 8am-5:30pm. If attempts to reach the examiner by telephone are

unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 571-272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

15. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Benjamin J Gillespie/
Examiner, Art Unit 1796

/Vasu Jagannathan/
Supervisory Patent Examiner, Art Unit 1796